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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,623	12/04/2003	Andre Luiz Arias	01952.0052-01	5744

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EXAMINER	
SCHILLING, RICHARD L	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/726623	Arias et al
Examiner	**Group Art Unit**
RLSchilling	1752

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on 2-3-05.

☑ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1-9, 11-24, 26-29, 31-50 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☑ Claim(s) 23, 24, 26-29, 33, 32, 34-42 is/are allowed.

☑ Claim(s) 1-9, 11-15, 18-21, 33, 43-50 is/are rejected.

☑ Claim(s) 16, 17, 22 is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s)._____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other_____

Office Action Summary

1. Claims 11-13, 33, 43 and 44 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 11-13 depend on cancelled claim 10. Claim 33 depends on cancelled claim 30. Claims 43 and 44 refer to cancelled claim 10 to define structure and composition.

2. The amendment filed February 3, 2005 is objected to under 35 U.S.C. § 132 because it introduces new matter into the specification. 35 U.S.C. § 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment to page 9 which changes the radiation device wavelength range by changing the lower end point to 810 from 830. There is no support in the original specification or claims for the lower end point of 810.

Applicant is required to cancel the new matter in the response to this Office action.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (b) the invention was patented or described in a printed publication in this or a foreign country or in

> public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9, 11-15, 18-21 and 43-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Van Damme et al. '353 or Deroover et al. '728. Van Damme et al. (see particularly column

5, lines 1-9; column 5, line 66 - column 6, line 64; column 8, lines 25-44) and Deroover et al. (see particularly column 5, lines 1-40; column 6, lines 3-33; column 7, lines 4-27) disclose positive working thermal imaging elements comprising substrates, first polymer layers soluble in aqueous alkaline solution and second top layers of resins, including cellulose ester resins, less soluble in aqueous alkaline solution but made soluble by thermal imaging. The first polymer layers include novolak resins and polyvinyl phenols. The elements contain infrared absorbers for thermal imaging. If Van Damme et al. and Deroover et al. do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use the disclosed cellulose esters as the called for second or top layer polymers in Van Damme et al. or Deroover et al. The applied prior art, e.g. Van Damme et al. and Deroover et al., does not disclose methods of making elements, as set forth in instant claim 23, wherein the top layer is coated with solutions of the active compounds of instant claim 23 at temperatures above 50°C or any reason for doing so. However, while the working Examples in applicants' specification do show that temperature of coating can affect results, they do not show that elements as set forth in the applied prior art with upper layers containing active compounds as listed in instant claim 1 cannot be made by coating at

elevated temperatures and at times set forth in instant claim 1. The Examples in the specification do not show that coating at temperatures above 50°C necessarily produce different photographic products than the applied prior art for all of the solutions of instant claim 1 containing the said active compounds at any concentration, or at any concentration set forth in the ranges of the dependent claims, coated at the full range of temperatures and times of instant claim 1.

4. Claims 1-9, 11-15, 18-21 and 43-50 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hauck et al. '238. Hauck et al. '238 (see particularly column 2, lines 36-60; column 4, lines 40-61; column 12, lines 10-43; column 16, lines 15-26; column 16, line 43 - column 17, line 21) disclose positive working thermally imageable elements comprising a first layer soluble in aqueous alkaline solution, which includes phenolic resin, and a top layer of a second polymeric material which is not soluble in aqueous alkaline solution unless thermally imaged. The top layer is applied to the first layer by using a solution which may contain solubility suppressing components including polyacetals which is an active compound listed in instant claim 1. Hauck et al. also teaches adding cellulose esters to their top layers to improve resistance of the layer to blanket washes at concentrations up to

50% by weight. If Hauck et al. do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use top layers in Hauck et al. containing the polyacetal compounds disclosed in Hauck et al. as the required solubility suppressing compounds of Hauck et al. and/or use cellulose esters in the top layers of Hauck et al. in order to improve the resistance of the top layers to blanket washes as taught by Hauck et al. While Hauck et al. do not disclose coating their top layers at elevated temperatures of at least 50°C, as explained in paragraph 3 above, the elements of Hauck et al. may still be materially the same as the elements encompassed by the instant claims.

5. Claims 16, 17 and 22 are objected to as depending on rejected claims but would be allowable if written in proper independent form. The applied prior art does not disclose polyamine top layers or the layers of instant claims 17 and 22 as third layers over the top layers of the applied prior art.

6. Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a

final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc
March 28, 2005

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP ~~1400~~ 1752